

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Self, S.

Docket No.: 3455

Art Unit: 3725

In re:

Applicant: HIRSHBURGER, W., et al

Serial No.: 10/555,479

Filed: November 3, 2005

REQUEST FOR RECONSIDERATION

March 12, 2008

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is responsive to the Office Action of January
24, 2008.

The Examiner indicated that the Office Action was a Final Action, and also rejected the claims under 35 U.S.C. 102(b) as being anticipated by the U.S. patent to Hestily.

It is respectfully submitted that the finality of the Office Action can not be considered as justified. A second action should not be final "where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97 (c)", as specifically explained in MPEP § 706.07 (a). The Examiner herself did not contradict this conclusion, since there was no affirmative statement in the Office Action stating that "Applicant's amendment necessitated the new ground(s) of rejection".

The rejections in the previous Office Action were based on 35 U.S.C. 112 with no rejection at all based on prior art under 35 U.S.C. 102 or 103. Minor amendments to claim 1 were directed exclusively to eliminate indefiniteness as perceived by the Examiner. Since the scope of the claims was not changed, the Amendment itself did not necessitate the new grounds of rejection under 35 U.S.C. 102. The Examiner's attention is also respectfully directed to the fact that the applicant did not have an opportunity to respond

substantively to the prior rejection since it was not also issued pursuant to a Final Action, and then later withdrawn upon filing of an RCE.

It is therefore respectfully requested to withdraw the finality of the Office Action.

In connection with the Examiner's rejection of the claims under 35 U.S.C. 102(b) over the U.S. patent to Hestily, applicants wish to make the following remarks.

Claim 1, the broadest claim on file, specifically defines, in addition to other features, that the hand router 10 in accordance with the present invention has a suction air-drivable turbine which is used as the drive.

Turning now to the reference applied by the Examiner, and in particular to the patent to Hestily, it can be seen that this reference discloses a dustless portable electric router which has a motor 42 with an armature shaft 46 having a lower end, with a bit carrying chuck 48 attached to the lower end of the armature shaft. The router has a blower 82 with a rotor 84 connected to the upper end of the armature shaft 46 and driven by the armature shaft from the motor 42.

This construction disclosed in the patent to Hestily has nothing to do with the applicant's invention.

It is respectfully submitted that the rotor 84 of the blower 82 in the router of the patent to Hestily is not a turbine. The rotor 84 of the blower 82 of this reference also is not an air-drivable turbine. Instead, the rotor 84 of the blower 82 is drivable by the drive motor 84 through the armature shaft 46.

It should be further emphasized that rotor 84 in this reference is not only not a turbine, but also it can not drive the armature shaft 46 as a turbine could, since there is no airflow across the rotor 84 if the armature shaft were not driven to be rotated by the motor.

It is believed to be clear that the new features of the present invention which are defined in claim 1 are not disclosed in the patent to Hestily.

As for the Examiner's rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by this reference, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Hestily does not disclose each and every element of the present invention as defined in claim 1.

It is therefore respectfully submitted that the anticipation rejection of claim 1 based on the patent to Hestily should be considered as not tenable and should be withdrawn.

Claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal

respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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